

### **REMARKS**

In the non-final Office Action mailed February 10, 2006, the Examiner rejected claims 1-7, 11-18, 20, 26, 29, and 30 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication 2004/0128207 A1 to *Ray*; rejected claims 8-10, 19, 21, 22, 25, 27 and 28 under 35 U.S.C. § 103(a) as being unpatentable over *Ray* in view of U.S. Patent Application Publication 2003/0173405 A1 to *Wiltz et al.* ("*Wiltz*"); and rejected claims 23 and 24 under 35 U.S.C. § 103(a) as being unpatentable over *Ray* in view of U.S. Patent No. 5,481,464 to *Ramsden*.<sup>1</sup>

Claims 1-30 are pending in this application.

#### **Rejection under 35 U.S.C. § 102(e)**

Applicants respectfully traverse the rejection of claims 1-7, 11-18, 20, 26, 29, and 30 under 35 U.S.C. § 102(e) as being anticipated by *Ray*. In order for *Ray* to anticipate Applicants' claimed invention under Section 102(e), each and every element of each claim in issue must be found, either expressly described or under principles of inherency, in the reference. Further, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." (See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).)

Moreover, to qualify as a prior art reference under Section 102(e), a published application for a patent must be filed before the invention by the applicant for patent.

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<sup>1</sup> The Office Action contains statements characterizing the applied references and the claims. Regardless of whether any such statements are specifically identified herein, Applicants decline to automatically subscribe to any statements in the Office Action.

Where a published application is entitled to the benefit of the filing date of a provisional application under 35 U.S.C. 119(e), the critical reference date is the filing date of the provisional application if the provisional application properly supports the subject matter relied upon to make the rejection in compliance with 35 U.S.C. 112, first paragraph.  
(See MPEP 2136.03(III).)

In this case, the present application was filed in the U.S. Patent and Trademark Office on October 15, 2001 and is entitled to an effective date of invention of October 13, 2000, based on a claim of priority to Provisional U.S. Patent Application No. 60/239,926. In comparison, *Ray* was filed on September 6, 2001, after the Applicants' effective date of invention. Thus, to apply *Ray* under 35 U.S.C. § 102(e), the Examiner must rely on *Ray*'s claim of priority to Provisional U.S. Patent Application No. 60/230,795 ("the Provisional Application"), filed on September 7, 2000. The Provisional Application, however, fails to disclose the subject matter relied on by the Examiner to reject claims 1-4, 5-7, 11-18, 20, 26, 29, and 30 and, therefore, *Ray* does not qualify as prior art under Section 102(e).

In particular, the Provisional Application discloses a method for a mail delivery service in which, if an attempt to deliver an item to a recipient's physical mailbox fails, the item is returned to a local post office for recipient pickup and an e-mail notification that the item is at the post office is provided to the sender and the recipient. (See p. 1, Figs. 1 and 2.) However, the e-mail notification is provided after an attempt to deliver an item to the recipient's physical mailbox. (*Id.*) Thus, the Provisional Application does not disclose "notifying, based on [a] first delivery point, a recipient that [an] item is en

route" (emphasis added), as recited in claim 1. Moreover, because the Provisional Application merely discloses that an item is returned to a local post office after a failed delivery attempt, it does not disclose "accepting at least one instruction designating a second delivery point," as recited in claim 1. Since the Provisional Application fails to disclose the above-noted features of claim 1, *Ray* cannot be properly support a rejection of claim 1 under 35 U.S.C. § 102(e). Accordingly, Applicants respectfully request that the Examiner withdraw the rejection of claim 1 under 35 U.S.C. § 102(e) and allow the claim, along with claims 2-4, which are also allowable at least due their dependency from allowable claim 1.

Claims 5, 11, 12, and 30 although of different scope than claim 1, recite subject matter similar to that of claim 1. Accordingly, claims 5, 11, 12, and 30 are also allowable for the same reasons as given above for claim 1.

In addition, claim 6 recites, "notifying a sender that of the item that the item is undeliverable; [and] accepting a disposition instruction from the sender." As noted above with regard to claim 1, the Provisional Application discloses returning an item to a local post office when an attempt to deliver the item to the recipient's mailbox fails. (*Id.*) Thus, the Provisional Application does not teach "accepting a disposition instruction from the sender," as recited in claim 6. Because the Provisional Application fails to disclose, at least, this feature of claim 6, *Ray* cannot support a rejection of claim 6 under 35 U.S.C. 102(e). Therefore, Applicants request that the Examiner withdraw the rejection of claim 6 and allow the claim, as well as claims 7-10, which are also allowable due to their dependency from allowable claim 6.

Claim 13 although of different scope than claim 6, recites subject matter similar to that of claim 6. Accordingly, the Provisional Application also cannot anticipate claim 13 under 35 U.S.C. 102(e) for the same reasons given above for claim 6. Therefore, claim 13 is also allowable as well.

Furthermore, claim 14 recites “conditionally accepting a second delivery point of the item; and delivering the item to one of the first delivery point and second delivery point based on the conditional acceptance of the second delivery point.” The Provisional Application, in comparison, is silent as to these features of claim 14. Since the Provisional Application does not disclose the above-noted features, *Ray* cannot support a rejection of claim 14 under 35 U.S.C. 102(e). Nor can *Ray* support a rejection of claims 15-18, 20, 26, or 29 at least due to these claims dependence from claim 14. Applicants, therefore, respectfully request that the Examiner withdraw the rejection of claims 14-18, 20, 26, and 29, and allow these claims.

Rejection under 35 U.S.C. § 103(a)

The Examiner rejected claims 8-10, 19, 21, 22, 25, 27 and 28 under 35 U.S.C. § 103(a) as being unpatentable over *Ray* in view of *Wilz* and rejected claims 23 and 24 under 35 U.S.C. § 103(a) as being unpatentable over *Ray* in view of *Ramsden*. As Applicants pointed out in the Reply to Office Action dated October 20, 2005 (page 5), *Ray* is disqualified as prior art under 35 U.S.C. § 103(c) because Application No. 09/976,039 (the present application) and U.S. Patent Application Publication 2004/0128207 A1 (*Ray*) were subject to an obligation of assignment to the United States Postal Service at the time the invention of Application No. 09/976,039 was made.

(See M.P.E.P. § 706.02(I) (8th ed. 2001).) Because *Ray* is disqualified as prior art under 35 U.S.C. § 103(c), it cannot support a rejection under 35 U.S.C. § 103(a). Accordingly, Applicants respectfully request the Examiner withdraw his rejection of claims 8-10, 19, 21-25, 27 and 28 under 35 U.S.C. § 103(a) and allow the claims.

**CONCLUSION**


Applicants request reconsideration of the application and submit that the rejections detailed above should be withdrawn. Further, Applicants submit that pending claims 1-30 are in condition for allowance, and request a favorable action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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By:   
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